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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,302	02/06/2004	Lawrence J. Terzo	36194-95262	5443

7590 01/26/2006

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EXAMINER

WOOD, ELIZABETH D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/774,302

Applicant(s)

TERZO, LAWRENCE J.

Examiner

Elizabeth D. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/3/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***Specification***

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated in a timely manner.

***Oath/Declaration***

The oath providing the residence and mailing address of the inventor is proper.

***Claim Rejections - 35 USC § 112***

The rejections of the claims under the first and second paragraphs of 35 USC 112 are hereby withdrawn. The following new rejection is applicable:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4, 7-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite in the recitation of "a concrete mixture effective at an ambient temperature of..." as it is unclear what this statement means. What does effective mean? Concrete mixture can be considered "effective" as long as it cures. This terminology adds nothing to the claims under consideration.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 4, 7-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2003/0127026 to Anderson et al., for the reasons set forth in the previous office action.

***Response to Arguments***

Applicant's arguments filed May 10, 2005 have been fully considered but they are not persuasive. Applicant's arguments state that the examiner contends that Anderson

et al. inherently disclose applicant's invention, and therefore a prima facie case of obviousness has not been established.

This is not exactly the point the examiner attempted to make in the rejection. The point made by the examiner is that both substances employed by applicants are known additives. The addition of more than one such additive would have been obvious to the skilled artisan desirous of producing a concrete of certain characteristics, and there would clearly be the expectation of success when adding known substances for known reasons. The only question of "inherency" is the statement by the examiner that although the prior art may not recognize the intended use limitations recited by applicants, such would flow from the obvious selection of the two claimed components.

The applicants assert that there is no motivation to select the two particularly claimed components because the reference discloses a "laundry list" of additives. This is not convincing. Although a "laundry list" may be specified, it takes no undue experimentation to select known, specifically recited cement additives with the expectation that they will perform as desired. In fact, the skilled artisan might not even look to a reference, but would simply be aware that each of the substances under consideration are known, and known for particular uses. It has long been held that there is nothing unobvious in the selection of any number of additives for this reason. With respect to the particular effective amounts set forth in some claims, it is pointed out that these are known substances and the skilled artisan will know that which constitutes effective amounts. The skilled artisan will be expected to have access to numerous documents (such as those provided with applicant's response) that teach how, when

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and why to employ certain cement additives. There is nothing unobvious in arriving at effective amounts of additives.

Applicants appear to take the position that there is no reasonable expectation of success because Anderson et al. does not use their composition at low temperatures and in the presence of fly ash. The examiner has considered this position and agrees that there is some merit to this argument, if one takes into account the information set forth in the specification regarding the setting efficiency of the additive. **However**, applicant should note that the claims presented are in no way commensurate in scope with this position. With respect to the additive claim, it recites only "nitrite-based inhibitor" and "non chloride type accelerator". There is only one specific example of an effective composition. The examiner cannot conclude that the myriad other compounds that would fall within the scope of the broad terminology would be expected to provide the results obtained in the single provided example. Regarding the method claims, the same problem applies. Furthermore, arguments that the skilled artisan wouldn't expect the inventive composition to work well at low temperatures based on the Anderson preference for above 60F are not convincing because the instant claims recite "preparing a mixture effective" at certain temperatures, but fail to state effective for WHAT purpose. Moreover, all of the claims do not even require the presence of fly ash, and it would appear that the "effectiveness" of the composition resides in the use of fly ash at low temperatures.

The examiner suggests claiming the specific compounds in the specific amounts required by and demonstrated in the specification to provide unexpected results.

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Alternatively, the applicant could provide data demonstrating that different accelerators and inhibitors in different amounts also provide the benefits achieved with the two specific compounds already exemplified. The examiner notes that such showing would have to be quite extensive however, because the terms "non-chloride type accelerator" and "nitrite-based corrosion inhibitor" are so broad and embrace so many substances. A significant number of example would have to be presented to establish a trend that the "unexpected" results achieved by applicant would actually be expected across the broad range of possible combinations that fall within the generic claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 571-272-1377. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elizabeth D. Wood  
Primary Examiner  
Art Unit 1755

edw